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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/868,182 | 06/15/2001 | Jean-Paul Vidot | CELA:082 | 6962 |
| 7590 07/12/2004 | | | EXAMINER | |
| Parkhurst & Wendel Suite 210 1421 Prince Street Alexandria, VA 22314-2805 | | | LUONG, VINH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3682 | |

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,182

Applicant(s)

VIDOT ET AL.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 5-11 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Attachment.

1. The Amendment filed on April 14, 2004 has been entered.
2. The restriction and election with traverse of Figs. 1-3 in parent application are carried over to the instant Request for Continued Examination (RCE) Application. No claim is withdrawn from further consideration pursuant to 37 CFR 1.142(b).
3. The proposed drawing corrections and/or the proposed substitute sheets of drawings filed on November 24, 2003 have been partially approved as explained below:

(a) The proposed drawing corrections and/or the proposed substitute sheets of drawings of original Figs. 2 and 3 have been approved; and

(b) The proposed new sheet of drawings to add Fig. 9 has been disapproved because new Fig. 9 introduces new matter. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of, *e.g.*, the followings features:

(1) The tips 15 that are bent inward radially and continuously *uninterrupted* as shown in new Fig. 9. Applicants admit on page 11 of the Amendment filed on April 14, 2004 that "Fig. 9 shows *one possible example* of such 'deformable or flexible' tips 15." In other words, Applicants admit that the original disclosure implies that the tips 15 may be deformed in different ways, *e.g.*, in the forms of continuous and/or discrete curvatures. The specific showing of the deformation or flexion of the tips 15 *after the filing date* within a full spectrum of possible deformations or flexions of the tips 15 *on the filing date* is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 USPQ 679 (CCPA 1972) and *Ex parte George*, 230 USPQ 575, 578 (BPAI 1986). Put in another fashion, the concept that the tips 15 are bent inward radially and continuously *uninterrupted* relative to the axis 9 is not conveyed

in the original disclosure, thus, it introduces new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973); and

(2) The size, shape, and configuration of the chamber 27. The original specification does not disclose that the chamber 27 is changed in size, shape, and configuration, *etc.* as now shown in new Fig. 9. After the filing date, Applicants' specific showing of a size, shape, and configuration of the chamber 27 within a full spectrum of possible sizes, shapes, and configurations is considered under the present disclosure to be new matter. *Cf., In re Smith* and *Ex parte George, supra*.

4. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the locking means which is releasably engaged with the first external surface of the piston in claim 3; and (b) the external profile 18 which is disengaged from the matching profile 19 of the matching second surface in claim 7 must be shown or the features canceled from the claims. *No new matter should be entered.*

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The

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replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicants will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The original Fig. 2 shows that the profiles 18 and 19 are engaged from each other. The moved or alternate positions, such as, the engaged and disengaged positions of the locking means 15 and the profiles 18 and 19 are required to be shown in accordance with 37 CFR 1.84(h)(4).

5. The amendments filed May 14, 2003 and November 24, 2003 are objected to under 35 U.S.C. 132 because they introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: the description of new Fig. 9 in the specification on page 7, lines 11-34; page 8, lines 5-6, lines 10-15, and lines 24-26. For example, the deformation shown in new Fig. 9 is unsupported by original disclosure as explained in the disapproval of Fig. 9. Applicants are required to cancel the new matter in the reply to this Office Action.

6. Claims 3 and 5-11 are allowed.

7. Applicants' arguments filed April 14, 2004 have been fully considered but they are not persuasive.

First, Applicants contend that new Fig. 9 does not introduce new matter because, *inter alia*, page 4 of the original specification describes that the tips 15 bend in the direction of the piston. Applicants state:

Additionally, Applicants' respectfully submit that Fig. 9 shows *one possible example* of such "deformable or flexible" tips

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15. Accordingly, (1) the original disclosure describes such deformable or flexible tips 15 bending inward, and (2) Fig. 9 *is one example* of such deformable or flexible tips bending inward. Therefore, Fig. 9 is not new matter, because the drawing merely illustrates one possible example of tips 15 bending inward as described in the specification. Thus, Applicants have complied with the Examiner's request that a figure be included that shows the invention recited in claim 7, i.e., after activation of the charge, by illustrating one possible example of tips 15 after movement of piston 21 attached to tips 15 along axis 9, toward the right side of Figs. 2 and 9. (Emphasis added).

As seen in the quotation above, Applicants admit that the deformation or flexing of the tips 15 as now shown in new Fig. 9 is only *one possible example* of deformation or flexion of the tips 15 among a full spectrum of possible deformations or flexions of the tips 15. Therefore, new Fig 15 introduces new matter. *In re Smith* and *Ex parte George, supra*. Indeed, for example, the degree of the concavity of the curvature of the deformation as shown in Fig. 9 is unsupported by the record as filed. To the extent that Applicants have complied with the Examiner's request by adding new Fig. 9 by amendment, the Examiner respectfully submits that the claimed feature in claims 3 and 7 as required under 37 CFR 1.84(h)(4) should have been shown *on the filing date*. The Applicants are respectfully noted that Section 608.01(h) of MPEP states:

If the best mode contemplated by the inventor *at the time of filing the application* is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. (Emphasis added).

Second, Applicants state:

Fig. 9 shows the invention with the first and second mechanical elements separated along axis 9 wherein chamber 27 *inherently* is larger because of movement along axis 9 of piston 21 and attached tips 15. This is a natural result of operation of the

invention as disclosed in the specification, i.e., the elements moving along axis 9 after activation of the charge. Expansion in the size of chamber 27 is a natural and direct result of movement of elements originally shown in Fig. 2 before new separated arrangement after activation of the charge, shown in Fig. 9. *No new matter is shown in Fig. 9 because the chamber becomes larger as a result of operation of the invention.* Applicants respectfully submit that the shape of tips 15, admitted by the Examiner as being "deformable or flexible", and disclosed in the specification as bending inward toward axis 9 after the charge is activated, are part of the boundaries of chamber 27, having a first size/shape shown in the view of Fig. 2 before activation of the charge, and a second size/shape in the view shown in Fig. 9 after activation of the charge. Therefore, Fig. 9 is fully supported in the original disclosure and does not include new matter. (Emphasis added).

Our reviewing court stated "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-1952 (Fed. Cir. 1999) citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

In the instant case, expansion in the size of chamber 27 *may be, but is not necessary* a natural and direct result of movement of elements originally shown in Fig. 2 before new separated arrangement after activation of the charge, shown in Fig. 9. In fact, Fig. 2 shows that the piston 21 is slid back and forth in the rearward and forward directions along the axis 9. After the charge, if the piston 21 is slid forwardly, the chamber 27 is expanded or enlarged, however, if the piston 21 is slid backwardly, the chamber 27 is compressed or decreased. In

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other words, the deformation of the chamber 27 is dependent upon the movement of the piston 21. Therefore, Applicants have failed to show that the chamber 27 is *necessary* to be larger because of movement along axis 9 of piston 21 and attached tips 15. After the filing date, the specific showing of the expansion of the chamber 27 within a full spectrum of possible deformations (expansion and/or compression) of the chamber 27 after the charge is considered under the present disclosure to be new matter. *Cf., In re Smith and Ex parte George, supra.*

Third, Applicants state:

In Paragraph 5(b) of the Office Action, the Examiner also requests that external profile 18, which is disengaged from matching profile 19, as recited in claim 7, be shown in the figures. The Examiner correctly describes Fig. 2 as showing external profiles 18 and 19 forming a straight line. However, the Examiner goes on to describe them as "thus, they are engaged, from each other." This is *not* correct. Fig. 2 shows the invention prior to activation of the charge, and therefore all components are completely engaged with each other. In Fig. 2, profiles 18 and 19 are mated together. Fig. 9, showing the invention after activation of the charge, shows profiles 18 and 19 separated from each other because of movement of piston 21 and tips 15 to the right, along axis 9. Note that Fig. 9 shows the upper straight profile of tip 15 as having moved toward the right, leaving exposed, the upper straight profile of groove 19a. Thus, Fig. 2 shows them as engaged, and Fig. 9 shows them as disengaged. Thus, Fig. 9 as previously submitted, meets the Examiner request (b) stated in paragraph 5.

The Examiner agrees with Applicants that: (a) Fig. 2 shows the invention prior to activation of the charge, therefore, all components are completely engaged with each other; and (b) Fig. 9 shows the invention after activation of the charge, therefore, the profiles 18 and 19 are separated from each other. As seen in the quotation above, Applicants admit that Fig. 9 shows the invention after activation of the charge as claimed in claims 3 and 7, hence, Fig. 9 should have been submitted at the time of filing of the application. After the filing date, Applicants'

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showing of a specific mode of disengagement of the profiles 18 and 19 within a full spectrum of possible modes of disengagements introduces new matter. See *In re Smith*, *Ex parte George*, and *In re Hay*, *supra*.

For the reasons set forth above, the Examiner respectfully disapproves new Fig. 9 and maintains the objection to the amendment to the specification thereof.

8. This application is in condition for allowance except for the following formal matters: objections to the drawings and specification set forth above. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The Examiner can normally be reached on Monday - Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

July 2, 2004



Vinh T. Luong
Primary Examiner